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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,370	12/20/2001	Robert Uyeki	23484-031	9654
36614	7590	08/09/2006	EXAMINER	
MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,370

Applicant(s)

UYEKI, ROBERT

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-20,22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response of 5/19/06 has been entered. The examiner will address applicant's remarks at the end of this office action. Currently claims 1-5,7-20,22-28 remain pending.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5,7-20,22-28, are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al. (5726885).

For claims 1-4,8,18, Klein discloses a vehicle renting system. Klein discloses a terminal (HA or the card reader of each car), register means and central computer (D) with computing means, vehicle monitoring means (col. 6, lines 1-12), designated area (H1), communication means (1), and information device (either part of HA or 1). With respect to the limitation of the vehicle monitoring means being "geo-fencing means", the examiner interprets this to be a recitation to a GPS system, which is disclosed by Klein. The instant specification discloses the fact that "geo-fencing means" is a GPS system. The GPS system of Klein monitors the use of the vehicle and monitors the location of the vehicles **so that they can be tracked and accounted for as claimed**. The specifics of the whereby clause are present in the GPS system of Klein and satisfy what is claimed. Additionally, geo-fencing is a utilization of a GPS system for vehicle tracking so reciting "geo-fencing" is still just a recitation to a GPS system for the

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monitoring of the vehicles. Claim 2 also reinforces this position taken by the examiner because claim 2 is reciting that the vehicle monitoring means (which comprises the geo-fencing means) is a GPS system (exactly what Klein discloses).

For claims 5,14, applicant is reciting a method limitation and this has been considered to the extent that the prior art must be capable of doing what is claimed. Klein is fully capable of operating as claimed. Intended use limitations in article claims will be given minimal patentable weight.

For claims 7,20, the examiner feels that they read on a GPS device that is disclosed by Klein. A GPS device provides the ability to monitor the entry and exiting of vehicles from the designated area. A GPS unit is the device that is used to allow the function of the means plus function language to occur. "Geo-fencing" is and requires a GPS unit.

For claims 9-13,19, applicant has recited data and nothing more. This is considered to be non-functional descriptive material and because Klein uses input data, Klein anticipates this claim. The kind of data being used is non-functional descriptive material.

For claims 15,16,17, the card reader of Klein is vehicle mounted and reads information from an identification card as claimed. The kind of data being used is non-functional descriptive material.

For newly added method claims 22-28, Kline discloses the providing of a designated area for a user to obtain a vehicle from. The providing "geo-fencing means" is satisfied by the GPS system that Klein uses to track and monitor the vehicles with.

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Geo-fencing is and requires a GPS unit. Kline discloses that users can request the use of a vehicle at terminal HA, where the terminal accepts user input information, and can determine whether or not a vehicle is available for the user based on entered information (what vehicle is desired, how long, and is the vehicle presently being used or is it even available). The availability is communicated to the user as claimed.

3. Applicant's arguments filed 5/19/06 have been fully considered but they are not persuasive.

With respect to the argument that Klein does not disclose a geo fencing means to monitor the use of the vehicle, the examiner disagrees. Applicant has argued that geo fencing is an electronic net that uses GPS to detect when a vehicle is entering, exiting, or within a designated area. Applicant has argued that the GPS system *"by itself, cannot select and enclose a designated area of various radii, as described by applicant."* The examiner notes that nothing in the claim requires any kind of radii be created and the claim does not recite anything about an electronic net. The particulars that applicant seems to be arguing are not required in the scope of the claim. It appears that applicant is possibly arguing a means plus function 35 USC 112,6th interpretation for the term "geo fencing means", but the examiner notes that applicant has never invoked a 112,6th analysis for the claims. To be a proper means plus function 112,6th limitation, a function must be specified and the language must be written as a "means" for "doing a specified function". If applicant does not use this kind of format, 112,6th is not invoked. All that the instant pending claims recite is "geo-fencing means", which is

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not a 112,6th limitation. The claims do not require the creation of an electronic net and do not require areas of various radii as argued. The claims only recite a “geo fencing means” and then state “*whereby vehicles contained within, entering, or exiting the designated area can be tracked and accounted for*”. In the system of Klein, GPS is used so that vehicles can be tracked and accounted for, just as the claim specifies in the whereby clause. In Klein, a person using GPS to determine a vehicle location will be able to track and account for the vehicle because they know where the vehicle is. The location will allow a person to determine if the vehicle is entering, exiting, or within a certain area. Kline satisfies what is claimed.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Duvall (6665613), Durst et al. (6480147) disclose GPS systems that also have “geo-fencing”. The “Word Spy” document gives a definition for geofencing and includes a citation from 1997 that is evidence that geofencing was known prior to the filing date of the instant application. The examiner makes applicant aware of these references because if the claims were amended to actually require the geo fencing particulars that applicant has argued, these features are known in the art and in the opinion of the examiner, would have been obvious for one of ordinary skill to provide to the system of Klein. This feature is not novel even if it is claimed commensurate with what applicant has argued.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER